

## **REMARKS**

### **CLAIM STATUS**

Claims 1-27 are pending in this application. Claims 14 -23 have been withdrawn from consideration. It is again noted that claim 24 is an elected claim and that the outstanding Office Action is incomplete as pending claim 24 has not been properly treated.

### **CLAIM AMENDMENTS**

Claim 1 has been amended to be consistent with the specification (note page 17, lines 9-13 and 24-25, for example) and to make it clear that the main surface of holding device supports "the envelope during insertion of the sheets into the envelope." Claim 5 has been amended to correct a possible antecedent basis problem.

### **SUMMARY OF OFFICE ACTION**

The outstanding Office Action is a non-final Action that improperly notes that claim 24 has been rejected (see item 6 of the Office Action Summary (PTOL-326)), that presents a rejection of claims 1-3, 5, 6, 8-11, 13, 25, 26, and 27 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,251,425 to Kern (hereinafter "Kern"), and that presents a further rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern.

### **FAILURE TO CONSIDER CLAIM 24**

As noted above, the present outstanding Action has failed to treat claim 24 in terms of specifying the reasons for the apparent rejection of this claim set forth by item 6 on the Office Action Summary (PTOL-326). As noted in the last response, MPEP §707.07(d) requires that:

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection.

Not only does the outstanding Action once again violate MPEP §707.07(d), it also again violates Section 706.02(j) of the MPEP that notes that "[i]t is important for an examiner to

properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” This is more than mere guidance by the MPEP as 35 U.S.C. § 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly, setting forth all relied on rationales to support all rejections in an Office Action in a way that gives the applicant a fair opportunity to respond is mandated by the statute and not something that is left to the Examiner’s discretion.

Accordingly as the mere mention that claim 24 is rejected in item 6) on the Office Action Summary (PTOL-326) violates 35 U.S.C. § 132, MPEP § 706.02(j), and MPEP § 707.07(d), the provision of a complete Office Action that properly considers claim 24 is respectfully noted to be in order before any further Office Action can be made final.

#### **CLAIM REJECTION UNDER 35 U.S.C. § 102**

Page 2 of the outstanding Action presents the above-noted rejection of claims 1-3, 5, 6, 8-11, 13, 25, and 26 under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern. This rejection is traversed.

The outstanding Action (at page 2) alleges that the trap 13 and guide plate 16 of Kern can be interpreted as together corresponding to the claim 1 “holding device.” Previous Actions have only alleged that the package trap 13 was interpreted to correspond to the claim 1 “holding device.” Thus, the present outstanding Action has expanded the interpretation of the claim 1 “holding device” to include the plate 16, which is a fixed structure, to then assert that the holding device of Kern ‘425 maintains a fixed orientation during feeding and removing of the envelope, apparently because only the guide plate 16 portion is a fixed element.

Previously, guide plate 16 had been more reasonably interpreted to be a part of the Kern feed mechanism that was interpreted to correspond to the claim 1 “feed device” (along with elements 15, 19, and 20 illustrated by Figs. 5-7). The new interpretation that removes guide plate 16 from being interpreted to be a part of the Kern feed mechanism that corresponds to the claim 1 “feed device” and reinterprets the guide plate 16 to be a part of the claim 1 “holding device” (together with trap 13) is clearly unreasonable. This is because the claim 1 “feed device” (now

interpreted as being only elements 15, 19, and 20) must perform the function of “feeding the envelope to the holding device” (emphasis added). In this regard, any envelope being arguably “fed” by elements 15, 19, and 20 would already be on the guide plate 16 (being now interpreted to be part of the claim 1 “holding device”), namely already supported on guide plate 16. Clearly, no envelope 3 from the stack 1 can be conveyed to the elements 15, 19, and 20 to be fed by these elements without first passing over the guide plate 16. Accordingly, it is clear that interpreting the trap 13 and guide plate 16 of Kern as together corresponding to the claimed “holding device” is without merit even without consideration of the present amendment to claim 1.

In this last regard, it is clear that amended claim 1 even further distinguishes over the teachings of Kern because it requires that the only reasonable interpretation of the claim 1 “holding device” is necessarily restricted to the trap 13 of Kern. This is because claim 1 now recites that the main surface of the holding device is “for supporting the envelope during insertion of the sheets into the envelope.” Clearly, the guide plate 16 does not support the envelope during the insertion of the sheets, since the envelope is instead supported on the trap 13 during insertion of the sheets into the envelope. See Fig. 6 of Kern that clearly shows envelope 3 as being completely off of the guide plate 16 and solely supported on the trap 13 during insertion of the content 38 (sheets or any other content) into the envelope. Thus, the only thing that has a surface that will support “the envelope during insertion of the sheets into the envelope” is the trap 13, not the guide plate 16.

Further as argued in the previous response, the claim 1 “holding device” must remain in the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal directions. In stark contrast to the claim 1 “holding device,” the trap 13 of Kern, the only element of Kern that can possibly be reasonably interpreted to correspond to the claim 1 “holding device,” must pivot to be in different orientations for feeding and removing the envelope.

Accordingly, as Kern cannot be reasonably said to teach all the limitations of amended independent claim 1, the rejection of independent claim 1, and claims 2, 3, 5, 6, 8-11, 13, 25, and 26, all of which ultimately depend from claim 1, under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern is clearly improper and should be withdrawn.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

Claims 4, 7, and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kern. This rejection is respectfully traversed.

First, it is noted that claims 4, 7, and 12 all depend from amended independent base claim 1 and that the rationales offered to reject these claims do not cure the above-noted deficiencies of Kern as to not teaching or suggesting all the subject matter recited by this amended independent base claim. Thus, the rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern is improper for at least this reason.

In addition, the rationales offered to reject claims 4, 7, and 12 are also all also clearly erroneous.

The first clear error as to claim 4 is the reliance on the guide plate 16 as suddenly being combined with element 15 (instead of with trap 13) to form the claim 4 required “curved guide plate with a vacuum device,” instead of the claim 1 “holding device.” The second clear error as to the rejection of claim 4 is the repeated reliance on improper substitutes for the required showing of substantial evidence demanded by the Administrative Procedure Act (APA). *See In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

The clear error as to claim 7 is the attempt to substitute an improper rationale as to a supposed rearrangement of parts for the above-noted required showing of substantial evidence mandated by the APA.

The clear error as to claim 12 is the attempt to substitute an undocumented and clearly speculative conclusion as to “engineering design choice” for the above-noted required showing of substantial evidence under the APA.

Thus, the rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern is improper and should be withdrawn for these reasons as well.

**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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